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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,276	12/06/2001	Roy L. Barrus	SHP024.2	4052

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EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 02/12/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,276

Applicant(s)

BARRUS ET AL.

Examiner

Catherine S. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 15-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14 and 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4,8,9.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Species E (Figures 19-32) in Paper No. 13 is acknowledged. The traversal is on the ground(s) that (i) all the species are so closely related thereby not creating an undue burden and (ii) the claims which would correspond to the combined specie would also include 1-40.

This is not found persuasive because even though all the figures represent a needle shield, each grouping of figures (see election requirement dated 10/06/2003) represents a structurally different embodiment of a needle shield. Applicant's own specification refers to the groupings of the figures as showing different embodiments of the invention. These embodiments do not require identical searches as asserted by applicant. Each embodiment has different structures which require a different field of search not needed for the other embodiments. The key words used for searching the species of figures 19-32 will not result in obtaining proper prior art for the species of, for example, figures 1-8. Specifically, the slider and needle guide, specific to that embodiment, would not be found because those limitations are not included in species E.

Additionally, claims 1-40 are not generic to all the species let alone a combined species. While applicant has elected all the claims to read on species E, claims 10 and 15-32 contain subject matter not shown in figures 19-32. Specifically, the "slider" of claim 10 and the "needle guide" of claim 15 are not shown in the embodiment of elected species E.

The examiner agrees that claims 1, 33 and 38 are generic. The requirement is still deemed proper and is therefore made FINAL.

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Claims 10 and 15-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Reference to some of the earlier applications that application 09/892,593 claims priority to are missing. Specifically, 09/892,593 is a CIP from apps #s 09/433,449; 09/434,036; 09/619,190 and also claims the benefit of 60/275,810 and 60/275,886. These earlier applications must be reference with their current status in order to receive the priority benefit.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thorne (US Pat# 5,823,997). Thorne discloses a safety shield apparatus including needle (40) and a shield (see figures 9-10). The shield includes at least one elongated part with a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface (206). The shield is shown being extensible between a retracted position and an extended position via relative movement between the surface (206) and the proximal portion of the shield. The device further includes a needle hub (180), an appendage wing with a hole (150), segment (160) and channel (220). A latch (212) is shown in figure 9 with an arm having a plurality of surfaces including an arcuate surface.

Claims 1-3, 5-9, 11-14 and 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell (US Pat# 5,997,504). Bell discloses a safety shield apparatus including needle (16,18) and a shield (see figures 12A-12C). The shield includes at least one elongated part with a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface (120). The shield is shown being extensible between a retracted position and an extended position via relative movement between the surface (120) and the proximal portion of the shield (see figures 12A-12C). The device further includes a needle hub (104), an appendage wing (44), segment (28) and channel (inside 28). A latch (112) is shown in figure 12D with an arm having a plurality of surfaces including an arcuate surface. The needle is angularly displaced approximately 90 degrees (see figure 4A). The contact surface includes a

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plurality of openings (132,133) and an anchor (122) which is an adhesive pad (texturing). The distal end of the shield is hingedly attached to the contact surface (see figures 12A and 12B).

Conclusion

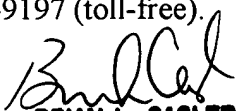
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat#s 4,966,589; 5,879,330; 5,921,969; 5,536,240; 5,445,618 disclose similar subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Catherine S. Williams *CSW*.
February 6, 2004


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